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In re Application of
GUEST et al. :
U.S. Application No.: 10/539,461 :
PCT No.: PCT/IB03/05665 :
Int. Filing Date: 22 December 2003 : DECISION ON PETITION
Priority Date: 20 December 2002 : UNDER 37 CFR 1.47(a)
Attorney Docket No.: 033327.0024 :
For: PAYMENT SYSTEM :
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This decision is issued in response to applicant's "Response to Dismissal of Petition under 37 CFR 1.47(b) and Renewed Petition under 37 CFR 1.47(a)" filed 26 September 2007.

Applicant's petition under 37 CFR 1.47(b) filed on 30 May 2006 was dismissed because the petitioner did not provide sufficient proof that the inventors could not be located and did not provide sufficient evidence of proprietary interest of the invention. Since the filing of the petition under 37 CFR 1.47(b), a joint inventor (Brian Tagg) has signed the declaration and the response to the Decision submitted 26 September 2007 will be treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 22 December 2003, applicant filed international application PCT/IB03/05665 which claimed a priority date of 20 December 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 June 2005.

On 20 June 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 31 October 2005, the United States Designated/Elected Office mailed a

Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 30 May 2006, applicant filed a petition under 37 CFR 1.47(b). In a decision dated 27 April 2007, applicant's petition was dismissed without prejudice.

Since the filing of the petition under 37 CFR 1.47(b), a joint inventor has signed the declaration and the "Response to Dismissal of Petition under 37 CFR 1.47(b) and Renewed Petition under 37 CFR 1.47(a)" filed 26 September 2007 will be treated as a petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3), and (4) have been satisfied.

Regarding item (2) above, petitioner states that John Guest has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in

support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, drawings, and oath/declaration) to John Guest. Marie LoPrestia states that inventor Guest has refused to take Applicant's telephone call; respond to applicant's email; and not allowed to have direct communication by Mr. Guest's co-workers. However, Ms. LoPrestia has failed to include evidence to demonstrate that the application papers were actually received by John Guest. Further, it appears that the application were mailed to Mr. Guest's corporate address. In this situation, the application papers should be submitted to the inventor at his last known residence address to insure receipt. Under these circumstances, where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant.

As stated above, in order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers were sent to John Guest and when such papers were sent and that John Guest has subsequently refused to execute the application.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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